

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* DONALD M. WHITE, III  
and  
CHRIS A. WADZINSKI

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Appeal No. 1999-2665  
Application No. 08/826,816

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ON BRIEF

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Before CALVERT, STAAB, and NASE, *Administrative Patent Judges*.  
STAAB, *Administrative Patent Judge*.

*DECISION ON APPEAL*

This is a decision on an appeal from the examiner's final rejection of claims 1-10 and 45-50, all the claims currently pending in the application. An amendment filed subsequent to the final rejection on January 11, 1999 (Paper No. 9) has been entered.

Appellants' invention pertains to a filament trimmer

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having a spool for retaining a supply of filament line, and in particular to a spool having a plurality of deformable crush ribs carried on the core of the spool for absorbing compressive forces caused by contraction of the wound filament line on the core that tends to warp or damage the spool. A further understanding of the invention can be derived from a reading of independent claims 1 and 9, which appear in the appendix to appellants' brief.

The references applied by the examiner in the final rejection are:

Bachi	3,989,200	Nov. 02, 1976
Sauber	4,657,202	Apr. 14, 1987
Ota	4,672,798	Jun. 16,

1987

The following rejections are before us for review:

(A) claims 48-50, rejected under 35 U.S.C. § 112, first paragraph, "on the basis that there is no written description of the claimed subject matter" (answer, page 3).

(B) claims 1-10 and 45-50, rejected under 35 U.S.C. § 103 as being unpatentable over Ota in view of Sauber and Bachi.

Reference is made to appellants' brief (Paper No. 8) and the examiner's final rejection and answer (Paper Nos. 6 and

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11) for the respective positions of appellants and the examiner regarding the merits of these rejections.

*The 35 U.S.C. § 112, first paragraph, rejection*

In the portion of the "Response to Argument" section of the answer directed to this rejection, the examiner states:

. . . [A]n amendment to the claims or the addition of a new claim must be supported by the description of the invention in the application as filed. *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989). It is noted that claims 48-50 were new claims added in an amendment. Therefore, while the examiner admits that the claimed rib orientation is clearly shown in the drawings, there is no written description in the specification of the claimed rib orientation as required by 35 U.S.C. [§] 112, first paragraph.  
[Answer, page 4.]

With respect to the description requirement found in the first paragraph of 35 U.S.C. § 112, it is well established that

[t]he test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language.

*In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed.

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Cir. 1983) (citations omitted). Additionally, "under proper circumstances, drawings alone may provide a 'written description' of an invention as required by § 112." *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1565, 19 USPQ2d 1111, 1118 (Fed. Cir. 1991).

Based on these well established principles, and the examiner's express admission that the rib feature of claims 48-50 is clearly shown in appellants' drawing figures, the examiner's 35 U.S.C. § 112, first paragraph, rejection of claims 48-50 as being based on a written description that fails to provide descriptive support for the invention as now claimed is inappropriate and will not be sustained. The examiner may, however, wish to have appellants amend the specification to incorporate the terminology of claims 48-50 therein in order to bring the specification and claims into compliance with 37 CFR

§ 1.75(d)(1).<sup>1</sup>

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<sup>1</sup>See 37 CFR § 1.75(d)(1) and MPEP § 608.01(o). 37 CFR § 1.75(d)(1) reads as follows:

The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find

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*The 35 U.S.C. § 103 rejection*

The examiner characterizes Ota, the primary reference, as disclosing a filament trimmer "substantially as claimed" except for means carried on the filament line spool for absorbing compressive forces caused by contraction of the line on the core of the spool (final rejection, page 4). In point of fact, Ota is

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clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.

representative of filament trimmers of the type called for in the preamble portion of appellants' Jepson-type claims 1 and 9, the two independent claims on appeal here.

Sauber pertains to "cable support devices onto which [a] pulling line used for positioning electrical or like cable may be wound" (column 1, lines 7-8). Sauber explains that when pulling heavy cables, "forces are generated which accumulate and tend to collapse the drum or spool onto which the pulling line is being wound" (column 1, lines 35-37). Sauber's solution to this problem is to provide a plurality of tension absorbing rollers 26 made of rubbery material on the central core of the drum. The core of the drum comprises recesses 32 that accommodate the rollers 26 and provide space into which the rollers may expand as they absorb tension.

Bachi is directed to a bobbin or mandrel of unorthodox cross-section onto which wire may be wound to make non-circular "perfect layer" electrical coils (see, generally, columns 1 and 2). Bachi's invention comprises the provision of wire support means 25 on one side of the bobbin or mandrel that slightly stretches the wire as it is laid thereon to give the wire a slightly convex profile. Figures 4, 5, and 6

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illustrate three different ways in which this can be achieved.

Of particular

interest to the examiner is the Figure 5 embodiment, wherein one side of the bobbin or mandrel is provided with a pair of lands or ridges extending along the full length thereof.

In rejecting the claims under 35 U.S.C. § 103, the examiner contends that it would have been obvious in view of Sauber and Bachi

to provide the filament retention means of Ota with means for absorbing compressive forces caused by contraction of the line on the core, wherein the means includes a plurality of deformable crush ribs extending outwardly from the core and spaced apart relative to the core, and wherein the core, flanges, and ribs are integrally molded in one piece from a plastic material, in order to facilitate filament retention and prevent damage to the filament line and/or spool as well as facilitate manufacture of the spool. [Final rejection, pages 4-5.]

Appellants argue as a threshold issue that Sauber constitutes non-analogous art; however, even assuming *arguendo* that Sauber is analogous art, and further that Sauber suggests providing shock absorbing means on the core of Ota's spool, the rejection is not sustainable. Independent claim 1 calls for the core of the spool and the shock absorbing means to be "integrally molded in one piece from a plastic material," and independent claim 9 contains similar limitations. As noted above, Sauber teaches that tension absorbing rollers 26 should



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be a rubbery material different from the material of the drum to absorb shock. Bachi does not teach shock absorbing of any type, notwithstanding the examiner's unsupported conclusion that the material of Bachi's bobbin "is made of deformable material and thus the ribs inherently deform at least to some extent" (answer, page 5). Thus, there is no suggestion in the combined teachings of the applied references of providing the tension absorbing means of Sauber as integrally molded one piece extensions of the core, as called for in each of the independent claims on appeal. In essence, the examiner's rejection is a hindsight reconstruction of appellants' invention using the disclosure of the present application as a blueprint.

For these reasons, the examiner's § 103 rejection of the appealed claims will not be sustained.

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*Conclusion*

The decision of the examiner finally rejecting the  
appealed claims is reversed.

*REVERSED*

IAN A. CALVERT	)	)
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
LAWRENCE J. STAAB	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

LJS:hh

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